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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,057	03/31/2004	Wanzhu Hou	26293-168739	5257
38598	7590	03/18/2008		
ANDREWS KURTH LLP 1350 I STREET, N.W. SUITE 1100 WASHINGTON, DC 20005			EXAMINER NGUYEN, VI X	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 03/18/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/813,057

**Applicant(s)**

HOU ET AL.

**Examiner**

Glenn K. Dawson

**Art Unit**

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 13, 15, 16, 18-20 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 13, 15, 16, 18-20 and 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Objections***

Claims 13,16 and 19 are objected to because of the following informalities: each of these claims include a reference to a figure of the specification. This is not the proper format of a claim and these references must be deleted. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16,18,25,26,28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, there is no antecedent basis for “said multiple metal members”.

In claim 25, there is no antecedent basis for “said electrically conductive metal”

In claim 26, there is no antecedent basis for “said metal member”, as more than one have been claimed.

In claim 28, there is no antecedent basis for “said electrically conductive metal”.

In claim 29, there is no antecedent basis for "said metal member".

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13, 3-5,16,19 and 22-30 are rejected under 35 U.S.C. 101  
because the claimed invention is directed to non-statutory subject matter.

All of these claims include contact of the metal members with the  
acupoints. This positively combines the device with the patient's head which is  
non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35  
U.S.C. 102 that form the basis for the rejections under this section made in this  
Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the

applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-5,13,15,16,18-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over loan-'174 in view of Kramer-'020 and Wang Wei, et al.-World Journal of Acupuncture-Moxibustion vol. 10 no. 3, September 2000.

loan discloses a cap with hard nubs for applying pressure to points on the scalp. However, the nubs are not metallic. Kramer discloses metallic acupressure applying nubs. It would have been obvious to have used metal for the nubs of loan, as the only requirement for the nubs is that it be a hard material. One of skill in the art would have had every reason to expect success with either metallic or plastic or rubber nubs, as they would all have the requisite "hard" characteristic necessary to provide the required pressure upon the desired point. The expected result would have been a support with metal nubs capable of exerting pressure upon acupoints for treating of insomnia, headaches or other maladies tied thereto. Metallic nubs would also allow for the use of magnetic therapy. loan also discloses that the nubs are located to apply pressure to multiple acupressure points on the scalp. Wei discloses that

it was known to use Baihui 20 as a treatment site for insomnia because it regulates mental activities and tranquilizes the mind. Additionally, all of the other claimed acupoints were known to assist in the treatment in either insomnia or headaches. It would have been obvious to have placed the nubs (which would be metallic when combined with the teachings of Kramer) on locations on the interior of the cap disclosed by loan which would impinge on the claimed acupoints, as these have been known to assist in the treatment of both headaches and insomnia, and the examiner contends that accessing all of these points simultaneously would have been expected to be an effective treatment for insomnia and headaches.

### ***Response to Arguments***

Applicant's arguments filed 11-29-2007 have been fully considered but they are not persuasive.

loan discloses a cap for placement on the head, the cap having a plurality of acupressure nubs for impinging on known acupoints on the scalp. However, the nubs being metal and the exact acupoints pressed on by the nubs are not disclosed by loan. Kramer teaches an acupressure device including the use of the claimed metallic material for the nubs. The device can

be placed on the ears or the palms, but the examiner contends that the disclosure is not limited to these locations and one skilled in the art would have found the concept of placing a similar acupressure device on other locations of the body where other known acupoints exist would have been within the scope of the disclosure and within the knowledge of one skilled in the art. The metallic nubs of Kramer's device would have been an obvious known material from which to make the nubs of Ioan's cap. The Baihui acupoint, as well as all the other claimed acupoints, were previously known to treat either insomnia or headaches. A person suffering with either of these conditions would inherently be under stress or anxiety to some degree. Therefore, treatment of either insomnia or headache would inherently also relieve stress, tension or anxiety. The examiner also believes that Kramer's device would be useable on other locations of a patient's body, really anywhere where it could be attached such that an acupressure nub could be placed against a desired acupressure point.

Applicant states that a new use for a known device is patentable. This is only true for method claims, not product or apparatus claims.

Applicant states that long-felt need can be used to establish non-obviousness. Applicant states that no one prior to applicant established that



the Baihui acupoint was known to treat insomnia. This is unpersuasive given the citing of Wang Wei, et al. which clearly establishes that using the Baihui accupoint was known and used to treat insomnia due to its ability to regulate mental activities and tranquilize the mind. While the examiner has been unable to locate a “cap” with nubs for applying pressure to all of the claimed acupoints, the examiner contends that one skilled in the art when confronted with all of the cited prior art would have found it obvious to have placed the metal nubs of loan modified by Kramer on locations of the cap to press against the Baihui point, as well as all others which could assist in the treating of insomnia or stress/tension/anxiety relief. Applicant has not presented sufficient evidence of non-obviousness due to long-felt need to overcome this obviousness rejection.

MPEP: “the court stated that “[a]bsent a showing of a long-felt need or the failure of others, the mere passage of time without the claimed invention is not evidence of nonobviousness.” 392 F.3d at 1324-25, 73 USPQ2d at 1229-30.”.

“However, there is no showing that others of ordinary skill in the art were working on the problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art who were presumably working on the

problem knew of the teachings of the above cited references, they would still be unable to solve the problem. See MPEP § 716.04.”

People were aware of the ability of applying pressure to these acupoints provided treatment for headaches and insomnia before the invention by applicant. While the manner in which the pressure applied may have been different, providing a cap to hold the pressure-applying members in locations to impinge upon the proper acupoints is made obvious by loan which teaches of placing pressure-applying nubs on the interior surface of a cap worn on the head. Additionally, applicant failed to provide any evidence of long-felt need in the form of an affidavit.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd E. Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
21 February 2008

/Glenn K Dawson/  
Primary Examiner, Art Unit 3731